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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,033	04/30/2001	Edward Rebar	019496-005820US	4301

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EXAMINER	
JIANG, DONG	
ART UNIT	**PAPER NUMBER**
1646	

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,033	REBAR ET AL.	
	Examiner	Art Unit	
	Dong Jiang	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-95 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-95 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20, 87-94, drawn to a zinc finger protein and compositions thereof, classified in class 514, subclass 2.

II. Claim 21-24, 83-86, drawn to a nucleic acid encoding a zinc finger protein and compositions thereof, classified in class 536, subclass 23.5.

III. Claims 25, 26, and 31-35, 42-46, 51-58, 61-71, 75-79, and 95, drawn to a method of modulating VEGF genes comprising administering a zinc finger protein, classified in class 514, subclass 2.

IV. Claims 27-30, 72-74, drawn to a method of modulating a plurality of target sites comprising administering a plurality of zinc finger proteins, classified in class 514, subclass 2.

V. Claims 36-41, 47-50, 59, 60, drawn to a method of modulating VEGF gene expression comprising administering a zinc finger protein and a nucleic acid encoding a zinc finger protein, classified in class 514, subclass 44.

VI. Claim 80-82, drawn to a method of screening for a modulator of VEGF expression, classified in class 435, subclass 6.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to entirely different chemical entities being made of completely different building blocks and having completely different functions which functions are not capable of use together. The proteins of Group I are made of amino acids and may not be used to encode themselves or in nucleic acid assays while the nucleic acids are made of nucleotides and may not be used in protein bases assays.

The inventions of Groups III, IV, V, and VI are each unrelated one to the other. They each require different method steps and different method compositions. The method of Group III

requires only a single zinc protein composition be used while the method of Group IV requires multiple zinc proteins, thus requiring a search and consideration not necessary for examination of the method of Group III. The method of Group V requires an additional step of administering a DNA in a gene therapy method which is not required of any of the methods III, IV or VI and requires unique considerations and searches. The method of Group VI has requires different method steps and has a completely different outcome, that of identifying an agent, which is not reached by practice of any of the other methods.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the zinc proteins may be used to generate antibodies.

Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids may be used to express the polypeptide or in hybridization assays.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any single Group is non-cohesive for that required for any other Group, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Species Election

This application contains claims directed to the following patentably distinct species of the claimed invention:

Each of Groups I-VI is directed to zinc finger proteins listed in Tables 3 and 4, which amounts to 41 individual and distinct proteins, each with a distinct structure that appears to affect distinct functional characteristics such as activation or repression of angiogenesis, lymphogenesis and myelopoiesis. The search and consideration for each listed protein is unique and non-cohesive.

Therefore, in addition to election of a single group for examination, applicant is required under 35 U.S.C. 121 to elect a single disclosed species out of the 41 listed for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Further, it would appear that the ability to activate or repress VEGF expression and the results of such activation or repression are dependent on the species of zinc finger protein, therefore, if applicant elects any of groups III-V, applicant is further requested to indicate if the single elected species of zinc finger protein activates or represses VEGF gene expression and activates or represses angiogenesis, lymphogenesis or myelopoiesis and to indicate which claims read on the elected invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Advisory Information

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Dong Jiang, Ph.D.
Patent Examiner
AU1646
3/18/03

YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
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